

REMARKS

The Final Office Action dated May 7, 2008 contained a final rejection of claims 1-8 and 18-23. The Applicants have amended claims 1 and 18. Claims 1-8 and 18-23 are in the case. Please consider the present amendment with the attached Request for Continued Examination (RCE) under 37 C.F.R. § 1.114. This amendment is in accordance with 37 C.F.R. § 1.114. Reexamination and reconsideration of the application, as amended, are requested.

Rejection of claims 1-8 and 18-23:

The Office Action rejected claims 1-8 and 18-23 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Lavery et al. (U.S. Patent No. 6,791,707).

The Applicant respectfully traverses this rejection and contends that the Lavery et al. reference does not disclose, teach or suggest all of the elements of the Applicant's newly amended independent claims.

Specifically, Lavery et al. merely disclose an on-line automated printing system that includes a front-end customer setup and product setup modules available on a web server (see Abstract and Summary of the Invention of Lavery et al.). Although a Print Ready File is produced embodying the product to be printed in Lavery et al., clearly, Lavery et al. do **not** disclose, teach or suggest features of the Applicant's **newly amended** independent claims. Namely, Lavery et al. is missing the Applicant's claimed automatically pre-flighting the digital file at the designer location, including **automatically checking for common errors** associated during a prepress stage, automatically revising incorrect printing instructions and **automatically adding missing printing instructions** to the received document file.

Moreover, the Lavery et al. reference is missing the Applicant's newly added automatically providing at the designer location a remote proofing function for a customer of the document file to be printed and automatically tracking the printing of the document file by continuously monitoring and updating a status of the document file to be printed and creating a high performance file that contains the digital file with the automatically pre-flighted and automatically proofed document file and the shipping instructions. Support for these amendments can be found throughout the specification, and in particular, in paragraphs [0026] - [0039] of the Applicant's published patent application, U.S. Patent Publication No. 2005/0033589.

In addition, although Lavery et al. disclose at col. 10, lines 39-45 a customer selecting and ordering a particular product through the web site and the web site loading a pre-configured order form for the selected product, **the web site then transmits the data to the system which generates the Print Ready File** (e.g., as a unique PostScript file). In other words, Lavery et al. do not disclose, teach or suggest the Applicant's claimed "creating at the designer location a digital file that represents an image to be printed".

Instead, Lavery discloses that a customer (which the Examiner has treated as the claimed "designer") "inputs data" to be printed using on a web site of the printer. (see col. 10, lines 26-29 of Lavery et al.). Moreover, Lavery inputs that data in a "pre-configured order form." (see col. 10, lines 40-43 of Lavery et al.). Basically, Lavery et al. provide data to another so that they may create such a file. Hence, entering data into a web based order form is not creating a file "at the designer location", like the Applicant's claimed invention.

Further, Lavery et al. do not disclose or suggest the Applicant's **real time configuration information** regarding a print production device at the print service provider location, generating at the designer location shipping instructions being generated **relative to the received configuration information** and creating at the designer location a high performance file that contains the digital file and the shipping instructions. Instead, the Lavery et al. reference expressly states that the "system" generates a Print Ready File using the data provided by the customer/designer.

Therefore, because the Lavery et al. reference is missing at least one feature of the independent claims, the Applicant submits that a prima facie case of obviousness does not exist. As a result, the independent claims are patentable over Lavery et al. As such, withdrawal of the obviousness rejection of claims 1-8 and 18-23 is respectfully requested.

Rejection of claims 5-6 and 8-23:

The Office Action rejected claims 5-6 and 8-23 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Lavery et al. as applied to claims 1-2 and 18-19 and further in view of FedEx (since claims 9-17 are canceled, the Applicant assumes that this rejection contains a typographical error in that claims 5-6 and 18-23 are actually the subject of this rejection and NOT claims 8-23).

The Applicant respectfully traverses this rejection and contends that the Lavery et al. reference in combination with the FedEx reference does not disclose, teach or suggest all of the elements of the Applicant's claimed invention.

Since the FedEx reference does not remedy the deficiencies of the Lavery et al. reference, the Applicant respectfully submits that claims 5, 6, and 18-23 are allowable over the combination of Lavery et al. and FedEx for at least the same reasons that claims 1 and 18 are allowable over Lavery et al., as argued above. Therefore, because Lavery et al. alone or in combination with FedEx do not disclose, teach or suggest all of the features of the newly amended independent claims, the Applicant submits that a prima facie case of obviousness does not exist. As a result, the independent claims are patentable over Lavery et al. or the proposed combination of Lavery et al. in view FedEx.

Further, with regard to the dependent claims, since they depend from the above-argued respective independent claims, they are therefore patentable on the same basis. (MPEP § 2143.03). As such, withdrawal of the obviousness rejection of the claims is respectfully requested.

Thus, it is respectfully requested that all of the claims be allowed based on the amendments and arguments. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. Additionally, in an effort to further the prosecution of the subject application, the Applicants kindly requests the Examiner to telephone the Applicant's attorney at **(818) 885-1575**. Please note that all mail correspondence should continue to be directed to:

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